

Application No.: 10/701,953
Amendment Dated February 18, 2005
Reply to Office Action Of February 9, 2005

REMARKS

Applicants submit this paper in response to an Office Action mailed by the USPTO on February 9, 2005.

In the Office Action, the Examiner respectfully requests that applicants include with the present amendment a listing of all pending claims. For the Examiner's convenience, the entire content of the Amendment filed by applicants on November 9, 2004, is again provided below.

For the record, and as set forth in the Interview Summary Record filed on August 16, 2004, applicants are treating the Office Action as the only outstanding Office Action in the present application, with the July 19, 2004 Office Action having been withdrawn. This Amendment is being filed in response to the August 11, 2004 Office Action.

In the Office Action, the Examiner rejected claims 21, 22 and 23 under 35 U.S.C. §102(b) as being anticipated by Pirtle, Jr. (U.S. Patent No. 3,628,523). Applicants respectfully traverse that rejection.

Pirtle, Jr. is directed to a syringe for the injection of radioactive medicinal and diagnostic compositions into the body. The syringe includes a cylindrical body 10 formed of lead glass, with a hypodermic needle 13 being attached thereto. A stainless steel plunger 15 is slidably disposed within the cylindrical body 10. As indicated at column 3, lines 13-16, the external surface of plunger 15 is provided with a coating 20 of "soft resilient material...to aid in maintaining the plunger 15 in slidable engagement with the inner wall of the cylindrical body 10." Thus, lubrication between the inner wall of the cylindrical body 10 and the plunger 15 is provided by the resilient material 20 on the plunger 15.

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In contrast, applicants' invention, as recited by claims 21-29, provides "a lubricant disposed over a limited area of at least one portion of said inner surface of said tubular barrel." Applicants' invention provides a lubricant that is disposed over a limited area of the inner surface of the barrel. Pirtle, Jr., on the other hand, teaches a lubricant (i.e., the soft resilient material) on the plunger. Thus, applicants respectfully submit that their invention is not anticipated by Pirtle, Jr., because that reference fails to teach or suggest at least one element recited by the claims of the present invention - namely, "a lubricant disposed over a limited area of at least one portion of said inner surface of said tubular barrel." Moreover, applicants further respectfully submit that the disclosure of Pirtle, Jr. teaches away from their invention, as there is neither teaching nor suggestion of providing a lubricant anywhere other than on the plunger.

In view of the foregoing remarks, the clear absence of disclosure of Pirtle, Jr. of an element of claim 21, and the clear difference between applicants' invention and the disclosure of Pirtle, Jr., applicants respectfully submit that the Examiner's rejection of claims 21-23 as anticipated under 35 U.S.C. §102(b) by Pirtle, Jr. is no longer tenable and respectfully request withdrawal of that rejection.

The Examiner rejected claims 24-29 under 35 U.S.C. §103(a) as being unpatentable over Pirtle, Jr. in view of Funderburk (U.S. Patent No. 5,456,940), Richard et al. (U.S. Patent No. 4,252,118), Akhavi (U.S. Patent No. 4,266,559), and Tischlinger (U.S. Patent No. 3,889,351). Applicants respectfully traverse that rejection.

The Examiner has acknowledged that Pirtle, Jr. fails to disclose "the conventionality of (1) plastic syringes, (2) glass syringes, (3) and the use of silicone to provide a coating to the inner

wall of the syringe.” The Examiner has relied upon the various secondary references in an attempt to overcome the deficiencies in the disclosure of Pirtle, Jr. However, in view of the failure of Pirtle, Jr. to teach or suggest at least one element recited by claim 21, applicants respectfully submit that their invention is not rendered obvious by the Examiner’s proposed combination of Pirtle, Jr. and any of Funderburk, Richard et al., Akhavi, and Tischlinger, because none of those references overcome the deficiency identified above with regard to Pirtle, Jr. In fact, when discussing Funderburk, which is the reference relied upon by the Examiner as disclosing a system for lubricating a syringe barrel, the Examiner has correctly pointed out that Funderburk “does not teach that the lubricant should be limited to selected portions of the syringe.” To address that deficiency in the disclosure of Funderburk, the Examiner looks to Pirtle, Jr. However, applicants respectfully maintain that the Examiner’s reliance on Pirtle, Jr. to disclose lubricating a portion of the syringe barrel is incorrect. As noted above, Pirtle, Jr. only discloses providing a coating of soft resilient material on the plunger to “maintain the plunger 15 in slidable engagement with the inner wall of the cylindrical body 10.” Pirtle, Jr. neither teaches nor suggests providing a lubricant anywhere other than on the plunger. Applicants respectfully submit that such a disclosure teaches away from lubricating a limited area of a portion of the inner surface of the tubular syringe barrel, as recited by applicants’ claims.

In view of the forgoing remarks, and the remarks set forth above with regard to claims 21-23 and Pirtle, Jr., applicants respectfully submit that the Examiner’s rejection of claims 24-29 as being unpatentable over Pirtle, Jr. in view of Funderburk, Richard et al., Akhavi, and Tischlinger is no longer tenable and respectfully request withdrawal of that rejection.

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Applicants respectfully submit that this amendment is fully responsive to the Office Action, and that claims 21-29 are patentable over the prior art of record in the present application, and are thus in condition for allowance. Applicants thus respectfully request early and favorable reconsideration of the present application.

While no fees are believed due in connection with this amendment, applicant hereby authorizes the Commissioner to charge the fees necessary in connection with this amendment, and any other fees necessary in connection with this application, to Deposit Account Number 02-1666.

Any questions concerning this application or amendment may be directed to the undersigned agent of applicant.

Respectfully submitted,

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By: David M. Fortunato
David M. Fortunato
Attorney for Applicant(s)
Reg. No. 42,548
(201) 847-6940